

Appl. No. 10/676,397
Atty. Docket No. 9047MQ
Amdt. dated February 2, 2006
Reply to Office Action of September 2, 2005
Customer No. 27752

REMARKS

Status of the Application

Claims 1 to 8 are pending in the present application. Claim 1 is amended, the basis of which is in the specification on page 6, lines 5-6, and in claim 2. No new matter has been added.

Rejection Under 35 USC 112, First Paragraph

Claims 1-8 are rejected under 35 USC 112, first paragraph, since they allegedly fail to comply with the enablement requirement since the specification fails to identify how to obtain the claimed level of xylan since paper pulp generally contain high level of xylan.

The specification need not disclose what is known in the art. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), *appeal after remand*, 13 USPW2d 1871 (1990). The USPTO previously allowed US 5,810,972, Reinheimer et al., which disclosed in claim 13 the addition of "a dry weight percentage of 0.15% to 1.5% of xylan related to the dry weight of the cellulose fiber in the pulp". Based on the teaching of this reference as a whole, the PTO considered this level of xylan as enabled in allowing the claims therein. Therefore, the PTO considered that obtaining specific levels of xylan related to the dry weight of the cellulose fiber, was enabled by the teaching of Reinheimer, even though some types of cellulose contain high levels of xylan, as argued by the Examiner.

Therefore, Applicants respectfully assert that the skilled artisan could practice the claimed invention based on the disclosure of the present invention and the prior art, particularly Reinheimer, at the time of the filing of the application. Applicants respectfully request withdrawal of the 35 USC 112 rejection.

Rejection Under 35 USC §103

Claims 1-8 are rejected under 35 USC §103 over US 5,810,972, Reinheimer et al., (herein "Reinheimer"). In order for a single prior art reference to render a claim obvious, that single prior art reference must suggest or motivate one of skill in the art to modify the teachings of that single reference to obtain the claimed invention.

In order for Reinheimer to render the presently claimed invention obvious, Reinheimer's teaching (at a minimum) would have to motivate one of skill in the art to substitute a lower level of the xylan for the higher level of xylan described and taught as useful in Reinheimer to achieve the benefits of Reinheimer. No such suggestion is described in Reinheimer. The present issue is whether Reinheimer teaches or suggests the lower

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claimed level (0.005% to about 0.1%) of xylan. First, the claimed upper range, as amended, does not fall within the acceptable error limit of Reinheimer's lower range.

Secondly, the range described in Reinheimer suggests that one of skill in the art would need this range to obtain the benefits taught in Reinheimer. The Examiner indicates that because Reinheimer makes no negative statements in regard to the range of hemicellulose that is useful, that one of skill in the art would have a reasonable expectation of success in lowering the range. The issue is not whether a reference contains a negative statement with respect of a disclosed range, but what the reference *as a whole* suggests to one of skill in the art regarding the modification of that range. The benefits taught by Reinheimer are numerous -- increased strength and runnability while maintaining softness, as well as a reduction of energy needed for drying (see abstract). Furthermore, the examples in Reinheimer (col. 5 and 6) show that small increases in the levels of the galactomannan (0.2 v. 0.4% for example) result in large increases in rupture strength improvement (15% v. 44%). Therefore, this suggests that lowering the level of galactomannan, including xylan, may result in a disproportional *decrease* in the rupture strength. Also, this suggests that the full range of benefits obtained at lower levels of galactomannan would be unpredictable, and one of skill in the art would not have a reasonable expectation of success in obtaining these full range of benefits.

Therefore, Reinheimer does not suggest or motivate one of skill in the art to utilize the range of from about 0.005% to about 0.1% of the xylan, based on the disclosure of the higher xylan ranges taught in Reinheimer. Applicants respectfully request removal of the obviousness rejection.

Conclusion

In view of the above facts and arguments, the Examiner is respectfully requested to reconsider and withdraw all of the rejections. In view of the above, Applicants respectfully request reconsideration of the application and allowance of all of the claims.

Respectfully submitted,

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